

ATTORNEY DOCKET NO. 5725.0588-00
Application No.: 09/576,546

Applicant submits that the Examiner has mischaracterized part of the basis of traversal over the election of species requirement. The Examiner states on page 3 of the Office Action that "Applicants agree that the restriction requirement is proper set forth in MPEP § 803.01 when there is a serious burden on the Examiner, by showing separate classification, separate status in the art, or different field of search." Applicant did not make this argument. Instead, Applicant traversed the election of species requirement "on the grounds that the Examiner has not shown that there would be a serious burden to examine all of the recited species of fibers." (Response to Election of Species Requirement, dated December 21, 2000, at page 2) (emphasis in original). Applicant did not state that showing a different classification would provide a sufficient showing of serious burden. Most inventions require searching in multiple subclasses.

Applicant submits that the Examiner has merely stated that the field of search is burdensome without a sufficient showing. Indeed, the search would not be burdensome. All of the species can be examined together with the rest of the composition recited in claim 1. A proper search encompasses the other elements of claim 1, and that different fibers are claimed with the other elements of claim 1 is insufficient, alone, to show that the search is burdensome. For the foregoing reasons, and for the reasons of record, Applicant maintains her traversal of the restriction requirement and the election of species requirement.

III. Rejections Under 35 U.S.C. § 112, Second Paragraph

A. "chosen from"

Claims 4, 7, 15-17, 23, 24, and 28 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner alleges that the "chosen from" language is indefinite and that proper Markush language is "selected from the group consisting of." Applicant respectfully disagrees and traverses this rejection, as Applicant's claim language is not indefinite and Applicant has not used Markush language. Instead, Applicant has used proper alternative language. To that end, Applicant first addresses the indefiniteness issue, and then addresses the Markush language issue.

Although the Examiner alleges Applicant's "chosen from" claim language is indefinite, she does not support her argument with an explanation of why the language is allegedly indefinite. As the Examiner is undoubtedly aware, the primary purpose of the definiteness requirement is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what Applicant regards as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. § 112, first paragraph, with respect to the claimed invention. M.P.E.P. § 2173 (7th ed. 1st rev. 2000).

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Applicant submits that the public would be clearly informed of the boundaries of infringement of any patent claim resulting from the pending claims. Applicant has merely recited groups of compounds that form a composition, where compounds from each group can be chosen as indicated in the claims, a perfectly acceptable alternative claim construction allowed by M.P.E.P. § 2173.05(h). Applicant submits that a potential infringer would have no problem determining the components of the claimed compositions to avoid infringement thereof. The Examiner has furthermore not identified why the rejected claims fail to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant therefore respectfully submits that the Examiner has failed to set forth adequate basis for rejecting the pending claims as indefinite.

In this rejection, the Examiner voluntarily describes proper Markush language, alleging Applicant has not used it. Applicant, however, respectfully points out that she is not using Markush language, instead she is claiming composition components using PTO accepted alternative language. The phrase that Applicant has used in her claims, i.e., "X chosen from A, B, and C" is proper language and more accurately describes the claimed invention, i.e., defining that the inventive composition may contain one or more X, with each X independently being chosen from the group A, B, and C. For example, both Applicant's claim language and the Examiner's proposed change cover a composition of the present invention that may contain: A; A and B; or two A's, two B's and a C, as well

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as all other permutations. Applicant's claim language is more precise than the Examiner's suggested language, and the Examiner has shown no legal basis for requiring the Applicant to change it.

Section 2173.05(h) of the M.P.E.P. identifies examples of proper claim language that may be representative, but are not exclusive. In fact, the U.S. Patent and Trademark Office (PTO) has provided other representative examples of proper alternative claim language. Specifically, Applicant directs the Examiner to another example of proper alternative claim language set forth in the M.P.E.P: "wherein R1 is methyl or phenyl, X and Z are selected from oxygen (O) and sulfur (S)." *See* M.P.E.P. Appendix AI (PCT), Example 20, p. AI-44 of the 2000 edition. In these examples, the M.P.E.P. does not use the language "selected from the group consisting of" as suggested by the Examiner.

The PTO has also published model claims utilizing language similar to Applicant's preferred claim language, *i.e.*, X selected from A, B, and C, in the Training Materials For Examining Patent Applications with Respect to 35 U.S.C. Section 112, First Paragraph - Enablement Chemical/Biotechnical Applications, released August, 1996. These PTO training materials further clarify that "X selected from A, B, and C" is proper claim language. Following the background case law, training materials, and discussion regarding enablement, the PTO provides Examiners with several example specifications, claims, and model rejections and analysis. *See* Training Materials For Examining Patent Applications with Respect to 35 U.S.C. Section 112, First Paragraph -

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Enablement Chemical/Biotechnical Applications, at Enablement Decision Tree, August, 1996. The Examples provided demonstrate what the PTO considers to be proper and acceptable claim language. Example H, entitled "Endothelin Receptor Antagonists," provides a model claim with alternative claim language that reads "at least one hetero atom selected from N, S, and O," while Example J, entitled "Selectin-Mediated Cellular Adhesion," provides a model claim with alternative claim language that reads "wherein the substituent is selected from halogen, C₁₋₄ alkyl, trifluoromethyl, hydroxy, and C₁₋₄ alkoxy."

In light of these examples of proper alternative claim language provided by the PTO, it is clear that there is no reason for the Examiner to require Applicant to change the claim language of the pending claims. Accordingly, Applicant respectfully submits that this rejection under 35 U.S.C. § 112, second paragraph, is in error and respectfully requests that the rejection be withdrawn.

B. "TEFLON®"

The Examiner has rejected claim 7, under 35 U.S.C. § 112, second paragraph, as being indefinite because it contains a trademark. This rejection is traversed. The recited limitation is clear and definite and is acceptable for the same reasons that a similar limitation was considered acceptable in *In re Gebauer-Fuelnegg*, 50 U.S.P.Q. 125, 128 (CCPA 1941). Nevertheless, Applicant has amended claim 7 to remove the trademark

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TEFLON, since its generic name, polytetrafluoroethylene, is recited just before the trademark. Accordingly, Applicant respectfully requests withdrawal of this rejection.

C. Claim 28

Claim 28 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for reciting the phrase "and cosmetic and dermatological active agents." Applicant respectfully traverses this rejection.

The Examiner has suggested that Markush language may have been intended. Applicant does not intend for the elements recited in claim 28 to be considered part of a Markush group. Instead, Applicant has recited at least one ingredient chosen from the list of elements presented. The last elements include cosmetic active agents and dermatological active agents. If the "and" before the word "cosmetic" were removed, claim 28 would read as if each of the elements were an active agent. For example, the dispersant would read as a dispersant active agent. Similarly, the preserving agents would read as preserving agents active agent. Therefore, the claim would not make sense grammatically. Alternatively, in removing the word "and" before the word "cosmetic," the word "cosmetic" would stand alone and not make any sense. Thus, Applicant submits that the penultimate "and" ties the last two elements to the rest of the claim, and the last "and" ties the two elements to the phrase "active agent."

Applicant therefore submits that the scope of claim 28 is clear so the public is informed of the boundaries of what constitutes infringement of the patent, and that claim

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28 provides a clear measure of what Applicant regards as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. § 112, first paragraph, with respect to the claimed invention. Having met the requirement for definiteness, Applicant respectfully requests withdrawal of this rejection.

IV. Rejections Under 35 U.S.C. § 102

A. Arraudeau et al.

The Examiner has rejected claims 1, 4-7, 15-18, 20, 23, 24, and 26-32 under 35 U.S.C. § 102(b) as being anticipated by Arraudeau et al. U.S. Pat. No. 4,659,562. Applicant respectfully traverses this rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131 (7th ed. 1st rev. 2000). To support an anticipation rejection based on inherency, an examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *see also In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one).

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Independent claims 1, 29 and 30 recite, *inter alia*, an anhydrous care or make-up composition comprising fibers, wherein said fibers are compatibilized with a fatty phase by at least one polyol. As described in the specification, the "term 'compatibilization' means a total or partial solubilization or a dispersion, that is homogenous by optical microscope, of the fibers in the fatty phase." (Specification at page 8, lines 5-7). To anticipate claim 1 and its dependent claims, this claim element must be found in the cited reference, Arraudeau et al.

Arraudeau et al. do not disclose an anhydrous care or make-up composition comprising fibers, wherein said fibers are compatibilized with a fatty phase by at least one polyol. Instead, Arraudeau et al. disclose an anhydrous composition as either a compacted or non-compacted powder, or a product containing a fatty body and optionally one or more organic solvents. Arraudeau et al.'s fatty body can be an oil or a mixture of an oil and a wax. When it is an oil, the fatty body can be any one of many different oils, very few of which are polyols. With such picking and choosing, Arraudeau et al. cannot anticipate the claims of the present invention.

Furthermore, Arraudeau et al. require co-pulverization of its fibers with silica. This co-pulverization produces an intimate mixture, that cannot be separated by conventional mechanical means. Arraudeau et al., col. 1, lines 47-52. Finally, Arraudeau et al. fail to disclose the selection of a polyol and a compatibilization of fibers with a fatty phase by at least one polyol. Without this disclosure, Arraudeau et al. fail to disclose a

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claim element and therefore cannot anticipate claims 1, 29 and 30, and their dependent claims.

The remaining independent claim, claim 31 recites, *inter alia*, a method of improving the staying power over time and/or gloss of an anhydrous care or make-up composition containing a fatty phase and at least one polyol that is liquid at room temperature. Arraudeau et al. fail to disclose a method of improving the staying power over time and/or gloss of an anhydrous care or make-up composition. Without this disclosure, Arraudeau et al. fail to disclose the method of the remaining independent claim. Therefore, Arraudeau et al. fail to anticipate claim 31 and its dependent claim.

For the foregoing reasons, Applicant submits that none of her claims are anticipated by Arraudeau et al. Accordingly, Applicant respectfully requests withdrawal of this rejection.

B. Franzke et al.

The Examiner has rejected claims 1, 4-7, 14-18, 20, 23, 24, and 26-28 under 35 U.S.C. § 102(e) as being anticipated by Franzke et al., U.S. Pat. No. 5,965,146. Applicant respectfully traverses this rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131 (7th ed. 1st rev. 2000), citing, *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Moreover, the single source must disclose all of the

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claimed elements "arranged as in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

Applicant claims an "anhydrous care or make-up composition . . ." The term "anhydrous composition" is defined in the specification at page 5 as being "a composition comprising a homogeneous continuous fatty phase in which may be dispersed ingredients that are insoluble in the fatty phase, in the absence of surfactant or emulsifier, such as dyestuffs and cosmetic or dermatological active agents, including water." By this definition, an anhydrous care or make-up composition does not include an aqueous-based, ethanol-based or dimethyl ether-based composition.

Franzke et al. on the other hand, disclose an "aqueous or aqueous/alcoholic cosmetic composition . . ." See Franzke et al., abstract. Indeed, each of Franzke et al.'s examples disclose aqueous or ethanol based compositions. These compositions do not comprise a homogenous continuous fatty phase in which may be dispersed ingredients that are insoluble in the fatty phase. Aqueous and ethanol based compositions are not fatty phase based compositions. In other words, the compositions are not anhydrous.

Because Franzke et al.'s compositions are not anhydrous, they are different in kind from Applicant's presently claimed invention. In addition, since the Examiner has acknowledged that Franzke et al. does not teach the limitations of claims 15-17, they cannot be anticipated. In other words, Franzke et al.'s fails to disclose all of the claimed

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elements arranged as in the claim. Without disclosing all of Applicant's claim elements, arranged as in the claim, Franzke et al. cannot anticipate Applicant's claimed invention. Therefore, this rejection is improper, and Applicant respectfully requests its withdrawal.

Rejections Under 35 U.S.C. § 103

Claims 2, 3, 14-22 and 25-32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Arraudeau et al., in view of Bara et al., U.S. Pat. No. 6,177,091 B1 and Arnaud, FR 2 786 393 A1 (Abstract). Applicant respectfully traverses this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim elements. See M.P.E.P. § 2143 (7th ed. 1st rev. 2000). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2143 (7th ed. 1st rev. 2000).

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As stated in the § 102(b) rejection over Arraudeau et al. above, Applicant has recited in independent claims 1 (not rejected here, but discussed because claims dependent on claim 1 have been rejected), 29 and 30, an anhydrous care or make-up composition comprising fibers, wherein said fibers are compatibilized with a fatty phase by at least one polyol. In other words, this phrase is an element recited in claims 1, 29 and 30, and therefore claims dependent on those claims.

Arraudeau et al. fail to teach or suggest an anhydrous care or make-up composition comprising fibers, wherein said fibers are compatibilized with a fatty phase by at least one polyol. Because they fail to teach or suggest this claim element, Arraudeau et al. fail to teach or suggest all the claim elements and, thus, cannot be used alone to establish a *prima facie* case of obviousness. To make up for the deficiencies of Arraudeau et al., the Examiner must rely on the secondary references.

The first secondary reference, Bara et al., however, also fail to teach or suggest an anhydrous care or make-up composition comprising fibers, wherein said fibers are compatibilized with a fatty phase by at least one polyol. Bara et al. teach that their compositions may comprise a particulate phase that may consist of various powders, but no disclosure of fibers. Therefore, Bara et al. fail to make up for the deficiencies in the teachings of Arraudeau et al. and cannot help establish a *prima facie* case of obviousness of independent claims 1, 29 and 30 or their dependent claims.

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The other secondary reference, Arnaud et al., also fail to teach or suggest an anhydrous care or make-up composition comprising fibers, wherein said fibers are compatibilized with a fatty phase by at least one polyol. Arnaud et al. suggest using a liquid polyol to allow acexamic acid to be compatible with a lipid phase. There is no suggestion or motivation to add a polyol to the composition taught in Arraudeau et al. Arnaud et al. cannot help establish a *prima facie* case of obviousness of Applicant's claims, because they also do not make up for the deficiencies in Arraudeau et al.'s disclosure.

Because none of the references teach or suggest an anhydrous care or make-up composition comprising fibers, wherein said fibers are compatibilized with a fatty phase by at least one polyol, the references fail to teach or suggest a claim element. Therefore, the Examiner has not established a *prima facie* case of obviousness of claims 2, 3, 14-22 and 25-30.

Independent claim 31 and claim 32, are similarly not rendered obvious by Arraudeau et al. in view of Bara et al. and Arnaud et al. The primary reference, Arraudeau et al. fail to teach or suggest a method of improving the staying power over time and/or gloss of an anhydrous care or make-up composition containing a fatty phase and at least one polyol that is liquid at room temperature. Without teaching or suggesting these claim elements, Arraudeau et al. cannot be used alone to establish a *prima facie* case of obviousness of claims 31 and 32.

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The secondary references, Bara et al. and Arnaud et al., each fail to make up for the deficiencies of Arraudeau et al., because they each also fail to teach or suggest a method of improving the staying power over time and/or gloss of an anhydrous care or make-up composition containing a fatty phase and at least one polyol that is liquid at room temperature. In other words, all of the references cited in this rejection, when combined, fail to teach or suggest all of the elements of claims 31 and 32.

For the foregoing reasons, Applicant submits that the obviousness rejection is improper, and requests that the Examiner withdraw the rejection.

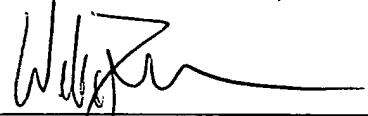
V. Conclusion

In view of the foregoing amendment and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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APPENDIX A: AMENDED CLAIM 7

7. (Amended) A composition according to Claim 1, wherein said fibers are chosen from silk fiber, cotton fiber, wool fiber, flax fiber, cellulose fibers extracted from wood, from plants or from algae, polyamide fiber, rayon fiber, viscose fiber, acetate fiber, cellulose fiber or silk fiber, poly-p-phenylene terephthamide fiber, acrylic fiber, polyolefin fiber, glass fiber, silica fiber, aramide fiber, carbon fiber, polytetrafluoroethylene [TEFLON®] fiber, insoluble collagen fiber, polyester fiber, polyvinyl chloride or polyvinylidene chloride fiber, polyvinyl alcohol fiber, polyacrylonitrile fiber, chitosan fiber, polyurethane fiber, polyethylene phthalate fiber, fibers formed from a mixture of polymers, and surgical fibers.